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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/334,617	06/17/1999	YOSHIHIRO IDA	P18051	5530

7055 7590 12/01/2005

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EXAMINER

GIBBS, HEATHER D

ART UNIT	PAPER NUMBER
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2627

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/334,617

Applicant(s)

IDA ET AL.

Examiner

Heather D. Gibbs

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-26, 28 and 30-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28, 31 and 32 is/are allowed.
- 6) ☒ Claim(s) 24-26, 33 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>09/08/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed on 08/19/2005 has been entered and made of record.
Claims 24-26,28,30-34 are pending.

Response to Arguments

2. Applicant's arguments filed have been fully considered but they are not persuasive. Applicant argues Saito does not disclose a memory configured to store reception capabilities regarding a type of facsimile data that the receiving facsimile apparatus can receive, the reception capabilities being distinct from the facsimile data; and a controller configured to receive the facsimile data from the transmitting facsimile apparatus, to transform the received facsimile data into a type of facsimile data that the receiving facsimile apparatus can receive, based on the reception capabilities stored in the memory, and to transmit the transformed facsimile data to the receiving facsimile apparatus. Upon further review, the Examiner finds these limitations to be expressly disclosed in Saito et al. Saito teaches where email data is converted to facsimile data and where received data is transmitted from a PC to IFAX and stored in data storage 25 (Col 4 Lines 36-42; and Col 5 Lines 49-57). This is evidence of the reception capabilities being distinct from the facsimile data. The controller 21 is configured to receive the facsimile data from the transmitting facsimile apparatus. See Col 3 Line 54- Col 4 Line 42).

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 24-27,29-30,33-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Saito et al (US 6,618,749)

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Regarding claim 24, which is representative of claim 30, Saito discloses a server apparatus connected with a transmitting facsimile apparatus and a receiving facsimile apparatus via the Internet (Fig 1), the server apparatus comprising', a memory 22,23configured to store reception capabilities regarding a type of facsimile data that the receiving facsimile apparatus can receive, the reception capabilities being distinct from facsimile data (Fig 2); and a controller 21configured to receive facsimile data from the transmitting facsimile apparatus, to transform the received facsimile data into a type of facsimile data that the receiving facsimile apparatus can receive, based on the reception capabilities stored in the memory, and to transmit the transformed facsimile data to the receiving facsimile apparatus (Fig 2; Col 4 Lines 36-42; Col 5 Lines 49-57; ABSTRACT).

Considering claim 25, Saito teaches the server apparatus according to claim 24, wherein a reception capability regarding a type of facsimile data is a type of file data that the receiving facsimile apparatus can receive (Col 5 Lines 49-57).

Regarding claim 26, Saito discloses the server apparatus according to claim 25, wherein a type of file data is at least one of MH, MR, MMR and JPEG (Col 4 Lines 36-42).

Regarding claim 27, Saito teaches A server apparatus connected with a facsimile via the Internet (Fig 1-2), the server apparatus comprising', a memory 22,23 configured to store reception capabilities regarding a type of facsimile data that the facsimile apparatus can receive, the reception capabilities being distinct from facsimile data (Fig 2); and a controller configured to receive, from the facsimile apparatus, an e-mail With a predetermined address, the e-mail indicating the reception capabilities of the facsimile apparatus to be stored in the memory, the controller being further configured to store the capabilities of the facsimile apparatus in the memory (Col 5 Lines 10- 29; Col 8 Lines 50-Col 9 Line 18).

For claim 29, Saito discloses An internet facsimile apparatus connected with a server apparatus via the Internet (Fig 1-2), the Internet facsimile apparatus comprising', a communicator configured to communicate with a server apparatus via the Internet (Fig 1-2), and a controller configured to transmit to the server by e-mail, reception capabilities regarding a type of facsimile data that the Internet facsimile apparatus can receive, the transmitted e-mail having a predetermined address, the e-mail indicating

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the reception capabilities of the Internet facsimile apparatus to be stored in the server apparatus (Col 5 Lines 10-29; Col 8 Lines 50- Col 9 Line 18).

With respect to claim 33, Saito discloses wherein the transmitting facsimile apparatus and the receiving facsimile apparatus comprise Internet facsimile apparatuses (Fig 3).

Regarding claim 34, Saito teaches wherein the controller transmits the transformed facsimile data to the receiving facsimile apparatus via the Internet (Col 4 Lines 15-18).

Allowable Subject Matter

4. Claims 28,31-32 are allowed.

Information Disclosure Statement

5. The information disclosure statement filed 09/08/2004 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because there is no English Abstract of JP 8-18717 in the file. The IDS has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

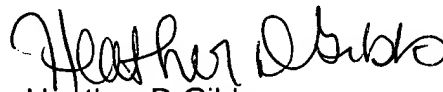
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heather D. Gibbs whose telephone number is 571-272-7404. The examiner can normally be reached on M-Thu 8AM-7PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Heather D Gibbs
Examiner
Art Unit 2627

hdg



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